

REMARKS

The February 24, 2006 Office Action was based on pending Claims 1–35. By this Response, Applicant is amending Claims 8–12, 14–17, 25–30 and 32–35 and is cancelling Claims 1–7, 13, 18–24 and 31 without prejudice or disclaimer.

Thus, after entry of the foregoing amendments, Claims 8–12, 14–17, 25–30 and 32–35 are pending and presented for further consideration. In view of the foregoing amendments and the remarks set forth below, Applicant submits that Claims 8–12, 14–17, 25–30 and 32–35 are in condition for allowance.

SUMMARY OF OBJECTIONS AND REJECTIONS

The February 24, 2006 Office Action objected to the disclosure of the Specification for its use of the terms “storage controller computer” and “storage manager computer.”

The Office Action objected to Claims 8–12, 14–17, 25–30 and 32–35 as being dependent upon a rejected base claim.

Claims 1–35 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1, 4–7, 13, 18, 21–24 and 31 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,154,787 to Urevig (“Urevig”).

Claims 2, 3, 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Urevig.

ALLOWABLE SUBJECT MATTER

Applicant thanks the Examiner for the indication of allowable subject matter in several of the pending claims. In particular, the Office Action objected to Claims 8–12, 14–17, 25–30 and 32–35 as being dependent upon a rejected base claim but indicated that such claims would be allowable if rewritten to overcome rejections under 35 U.S.C. § 112, second paragraph, and to include limitations of the corresponding base claim and any intervening claims.

In view of the foregoing, Claims 8, 12, 14–16, 25, 28, 30 and 32–34 have been rewritten in independent form to include limitations similar to those of the corresponding

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base claims and any intervening claims. As discussed in more detail below, Applicant also submits that Claims 8–12, 14–17, 25–30 and 32–35 as currently amended comply with the requirements of under 35 U.S.C. § 112, second paragraph. Applicant, therefore, respectfully requests allowance of Claims 8–12, 14–17, 25–30 and 32–35.

CANCELED CLAIMS 1–7, 13, 18–24 and 31

In order to expedite the prosecution of this application, Applicant has canceled Claims 1–7, 13, 18–24 and 31 without prejudice or disclaimer. Thus, Applicant respectfully submits that the Office Action's rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) are now moot.

Notwithstanding the foregoing, Applicant reserves the right to present, in a subsequent application, the subject matter of these canceled claims in independent form, or otherwise in or as a broader claim.

OBJECTION TO THE SPECIFICATION

The Office Action objected to the disclosure of the Specification because:

[I]t uses the terminologies “storage controller computer” and “storage manager computer” only in context, fails to explicitly define the terms, and fails to explicitly differentiate how the scope of one apparatus is structurally different from the other.

The Office Action also cites *In re Schreiber* and M.P.E.P. § 2114 for support of this objection. The Office Action then explains that the claimed devices disclosed in the specification “should be distinguished from the prior art in terms of structure rather than function.”

Applicant respectfully disagrees with this objection to the specification. In particular, Applicant submits that both the “storage controller computer” and the “storage manager computer” are well-described throughout the specification (see, e.g., Paragraphs 0021, 0037 and 0039–0041). Furthermore, both the case *In re Schreiber* and M.P.E.P. § 2114 relate to guidelines for determining whether or not an apparatus claim is distinguishable over the prior art. Neither *In re Schreiber* nor M.P.E.P. § 2114 appears to relate to the disclosure of the specification.

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In view of the foregoing, Applicant respectfully requests that the objection to the specification be withdrawn. If the Examiner elects to maintain such a rejection, Applicant respectfully requests the Examiner to provide a statutory basis for the rejection.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

The Office Action rejected Claims 8–12, 14–17, 25–30 and 32–35 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Office Action indicates that the claim terms “storage controller computer” and “storage manager computer” are indefinite because: (1) the terms are not “terms in the art having a well-defined scope of meaning (as [these terms do] not appear in a technical dictionary)” and (2) the terms have “not been explicitly defined in the claim or in the Specification.”

Applicant respectfully disagrees with the Office Action’s assertion that the claim terms “storage controller computer” and “storage manager computer” are indefinite. In particular, Applicant submits that there is no requirement that a claim term appear in a technical dictionary or be explicitly defined in the claim or specification. Rather, Applicant respectfully submits that the above-identified terms describe the claimed “subject matter with a reasonable degree of particularity and distinctness” in view of the specification and the knowledge of one possessing ordinary skill in the pertinent art (see requirements set forth in M.P.E.P. § 2173.02).

However, in order to expedite the prosecution of the present application, Applicant has amended the terms “storage controller computer” and “storage manager computer” in Claims 8–12, 14–17, 25–30 and 32–35 to recite a “computer.” Applicant, therefore, respectfully requests the rejection of Claims 8–12, 14–17, 25–30 and 32–35 under 35 U.S.C. § 112, second paragraph, to be withdrawn.

REQUEST FOR TELEPHONE INTERVIEW

Pursuant to M.P.E.P. § 713.01, in order to expedite prosecution of this application, Applicant’s undersigned attorney of record hereby formally requests a

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telephone interview with the Examiner as soon as the Examiner has considered the effect of the arguments presented above. Applicant's attorney can be reached at the general office number listed below.

CONCLUSION

In view of the foregoing, the present application is believed to be in condition for allowance, and such allowance is respectfully requested. If further issues remain, the Examiner is cordially invited to contact the undersigned such that the issues may be promptly resolved.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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